

REMARKS

I. Introduction

With the cancellation herein without prejudice of claims 17 and 18, and the addition of new claims 27 and 28, claims 14 to 16, 19, 20, 22, and 24 to 28 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Objection to the Drawings

Regarding the objection to the drawings, while 37 C.F.R. § 1.83(a) requires the drawings to show every feature specified in the claims, it also provides that “conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be” -- but are not required to be -- “illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation.” The feature of fuel-line arrays hydraulically positioned in parallel, now recited in claim 28, need not be illustrated since a detailed illustration thereof is not essential for a proper understanding of the claimed subject matter. It is respectfully submitted that those of ordinary skill in the art would properly understand the above features disclosed in the description and the claims, without need for further illustration.

In view of all of the foregoing, withdrawal of the objection to the drawing is respectfully requested.

III. Rejection of Claims 14 to 20, 22, and 24 to 26 Under 35 U.S.C. § 112, First Paragraph

Claims 14 to 20, 22, and 24 to 26 were rejected under 35 U.S.C. § 112, first paragraph, as to the enablement requirement. As an initial matter, claims 17 and 18 have been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claims 17 and 18.

It is respectfully submitted that one of ordinary skill in the art would understand the feature of fuel-line arrays hydraulically positioned in parallel. In this regard, the Substitute Specification describes this feature at page 3, lines 8 to 19; and page 7, line 25 to page 8, line 14.

Furthermore, the present rejection is not based upon the proper standard for determining compliance with the enablement requirement of 35 U.S.C. § 112, first paragraph. Rather, it appears that the present rejection reflects an apparent misapprehension of the enablement requirement of 35 U.S.C. § 112, first paragraph. An analysis for compliance with the written description requirement requires a determination as to whether the application, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed subject matter without undue experimentation. U.S. v. Teletronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988) (“The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.”). Among the factors that **must** be considered in an analysis for compliance with the enablement requirement are: (1) the breadth of the claims; (2) the nature of the invention; (3) the state of the prior art; (4) the level of one of ordinary skill in the art; (5) the level of predictability in the art; (6) the amount of direction provided by the inventor; (7) the existence of working examples; and (8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. In re Wands, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir. 1988). It is, however, improper to conclude that a disclosure is not enabling based on an analysis of only one of these factors while ignoring one or more of the other factors. That is, a proper analysis must consider all the evidence related to each of these factors. Rather than addressing any of these factors, the Office Action at page 3 merely contends that “Applicant’s parallel structure of fuel line arrays is not set forth in the specification in clear concise and exact terms.” As such, the present rejection is plainly deficient with regard to the proper showing required to establish that the enablement requirement is not satisfied.

Accordingly, it is respectfully submitted that the Office Action plainly fails to establish that claims 14 to 16, 19, 20, 22, and 24 to 26 do not comply with the enablement requirement.

Accordingly, it is respectfully submitted that claim 14, as presented, is allowable, as are its dependent claims 15, 16, 19, 20, 22, and 24 to 26.

It is therefore respectfully requested that the rejection be withdrawn.

IV. Rejection of Claims 14 to 17, 19, 20, 22, and 24 to 26 Under 35 U.S.C. § 103(a)

Claims 14 to 17, 19, 20, 22, and 24 to 26 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 3,125,078 (“Reiners”). As an initial matter, claim 17 has been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claim 17. It is respectfully submitted that Reiners does not render unpatentable the present claims for at least the following reasons.

In order for a claim to be rejected for obviousness under 35 U.S.C. § 103(a), the prior art must teach or suggest each element of the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990). In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007). Further, the Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. M.P.E.P. §2143.

Claim 14, as presented, relates to a fuel-injection system for the direct injection of fuel into a combustion chamber of an internal combustion engine, including, *inter alia*, the features of a cylinder head in which fuel lines are positioned, at least two fuel injectors, each of the fuel injectors having a fuel connection on a side thereof, the fuel connection having an outer first section and an inner second section, in which *the fuel lines are connected via at least two openings of the second section coaxial with the fuel lines*. Support for this amendment may be found in the Substitute Specification, e.g., at page 6, lines 19 to 22.

Reiners does not disclose, or even suggest, all of the claimed features of claim 14, as presented. Indeed, the Office Action does not even assert that Reiners discloses this claimed feature of claim 14, as presented. In contrast, Reiners merely indicates a single passage 31 in communication with supply bore 61. (Reiners, col. 5, lines 1 to 3). Thus, Reiners does not disclose, or even suggest, the feature that *the fuel lines are connected via at least two openings of the second section coaxial with the fuel lines*, as provided for in the context of claim 14, as presented.

Accordingly, Reiners does not disclose, or even suggest, all of the features included in claim 14, as presented. As such, it is respectfully submitted that Reiners does not render unpatentable claim 14.

As for claims 15, 16, 19, 20, 22, and 24 to 26, which ultimately depend from and therefore include all of the features included in claim 14, it is respectfully submitted that Reiners does not render unpatentable these dependent claims for at least the same reasons more fully set forth above.

In view of all the foregoing, withdrawal of this rejection is respectfully requested.

V. Rejection of Claims 14 to 17, 19, 20, 22, and 24 to 26 Under 35 U.S.C. § 103(a)

Claims 14 to 17, 19, 20, 22, and 24 to 26 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Reiners and U.S. Patent No. 6,810,546 ("Smith"). As an initial matter, claim 17 has been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claim 17. It is respectfully submitted that the combination of Reiners and Smith does not render unpatentable the present claims for at least the following reasons.

As more fully set forth above, Reiners does not disclose, or even suggest, the feature that *the fuel lines are connected via at least two openings of the second section coaxial with the fuel lines*, as provided for in the context of claim 14, as presented. Smith also does not disclose, or even suggest, the feature that *the fuel lines are connected via at least two openings of the second section coaxial with the fuel lines*, and thus, fails to cure this critical deficiency. Indeed, the Office Action does not even assert that Smith discloses this claimed feature of claim 14, as presented.

Accordingly, the combination of Reiners and Smith does not disclose, or even suggest, all of the features included in claim 14, as presented. As such, it is respectfully submitted that the combination of Reiners and Smith does not render unpatentable claim 14.

As for claims 15, 16, 19, 20, 22, and 24 to 26, which ultimately depend from and therefore include all of the features included in claim 14, it is respectfully submitted that the combination of Reiners and Smith does not render unpatentable these dependent claims for at least the same reasons more fully set forth above.

In view of all the foregoing, withdrawal of this rejection is respectfully requested.

VI. Rejection of Claim 18 Under 35 U.S.C. § 103(a)

Claim 18 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Reiners, Smith, and U.S. Patent No. 6,807,946 ("Koseki et al."). As an initial matter, claim 18 has been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claim 18. Since the features of canceled claim 18 have been included in claim 14, as presented, the present rejection will be addressed with respect to claim 14. It is respectfully submitted that the combination of Reiners, Smith, and Koseki et al. does not render unpatentable the presently pending claim for at least the following reasons.

As more fully set forth above, the combination of Reiners and Smith does not disclose, or even suggest, the feature that *the fuel lines are connected via at least two openings of the second section coaxial with the fuel lines*. Koseki et al. also do not disclose, or even suggest, the feature that *the fuel lines are connected via at least two openings of the second section coaxial with the fuel lines*, and thus, fail to cure this critical deficiency. Instead, Koseki et al. merely indicate a fuel passage 115 that is angled with respect to the delivery pipe 2A. (Koseki et al., col. 4, lines 8 to 16; and Figure 3). Thus, the fuel passage 115 of Koseki et al. plainly is not coaxial with the delivery pipe 2A. In fact, it appears that the passage 115 of Koseki et al. may be single annular, conical groove, particularly since Koseki et al. refer only to a single passage 115. (Koseki et al., col. 4, lines 11 to 12).

Accordingly, it is respectfully submitted that the combination of Reiners, Smith, and Koseki et al. does not disclose, or even suggest, all of the features included in claim 14, as presented. As such, it is respectfully submitted that the combination of Reiners, Smith, and Koseki et al. does not render unpatentable claim 14, as presented.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

VII. Rejection of Claims 14 to 20, 22, and 24 to 26 Under 35 U.S.C. § 103(a)

Claims 14 to 20, 22, and 24 to 26 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Reiners, Koseki et al., and Smith. As an initial matter, claims 17 and 18 have been canceled herein without prejudice, thereby rendering moot the present rejection with respect to claims 17 and 18. It is respectfully submitted that the combination of Reiners, Koseki et al., and Smith does not render unpatentable the present claims for at least the following reasons.

As more fully set forth above, the combination of Reiners, Koseki et al., and Smith does not disclose, or even suggest, the feature that *the fuel lines are connected via at least two openings of the second section coaxial with the fuel lines*.

Accordingly, the combination of Reiners, Koseki et al., and Smith does not disclose, or even suggest, all of the features included in claim 14, as presented. As such, it is respectfully submitted that the combination of Reiners, Koseki et al., and Smith does not render unpatentable claim 14.

As for claims 15, 16, 19, 20, 22, and 24 to 26, which ultimately depend from and therefore include all of the features included in claim 14, it is respectfully submitted that the combination of Reiners, Koseki et al., and Smith does not render unpatentable these dependent claims for at least the same reasons more fully set forth above.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

VIII. New Claims 27 and 28

New claims 27 and 28 have been added herein. It is respectfully submitted that claims 27 and 28 add no new matter and are fully supported by the present application, including the Specification.

It is respectfully submitted that claims 27 and 28, which ultimately depend from claim 14, are patentable over the references relied upon for at least the reason that the references relied upon do not disclose, or even suggest, the feature that *the fuel lines are connected via at least two openings of the second section coaxial with the fuel lines*, as recited in claim 14, as presented.

IX. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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